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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/837,351

04/17/2001

Richard F. Rudolph

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02/07/2006

INTERNATIONAL PAPER COMPANY
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LOVELAND, OH 45140

EXAMINER

YANG, CLARA I

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,351

Applicant(s)

RUDOLPH ET AL.

Examiner

Clara Yang

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 18 November 2005 have been fully considered but they are not persuasive. On page 6, the applicant argues that "[there] is absolutely no disclosure whatsoever that the RFID tag in the Hawley et al. 's system contain at least two read/write updatable fields in its memory." The examiner respectfully disagrees. First, in Section [0018], Hawley teaches that a tag for each prescription drug container specifies the URL of the manufacturer's home page (i.e., a first readable field), a data item identifying the particular drug (i.e., a second readable field), and information personalized to the individual purchaser (i.e., a third readable field). Thus Hawley's tag has at least two readable fields. Secondly, Hawley adds that a tag contains circuitry capable of receiving and storing additional information (see Section [0019]); thus Hawley's tag also has at least one writeable (i.e., updatable) field. For these two reasons, the examiner maintains the previous 35 USC § 102(e) rejection of claims 1-10.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawley et al. (US 2001/0021950).

Referring to claim 1, Hawley's system, as shown in Fig. 1, comprises: (a) a plurality of tokens 20, which are prescription drug containers (i.e., product containers) (see Sections [0011], [0018], and [0024]); (b) a radio frequency identification (RFID) tag associated with each token 20 (herein after referred to as "container 20"), wherein each RFID tag has data memory means for storing at least a unique identification code of the tag's microchip, the uniform resource locator (URL) of the drug manufacturer's home page (i.e., one remote storage access code for accessing additional data associated with container 20 and stored outside of the RFID tag's memory means), and a data item identifying the particular drug (see Sections [0018], [0019], and [0025]); and (c) reader 15 and computer 10 providing means for retrieving the unique identification code and URL from the RFID tag's memory means (see Sections [0024]-[0026]). Hawley teaches that a tag for each prescription drug container specifies the URL of the manufacturer's home page (i.e., a first readable field), a data item identifying the particular drug (i.e., a second readable field), and information personalized to the individual purchaser (i.e., a third readable field) (see Section [0018]); thus Hawley's tag has at least two readable fields.

Regarding claim 2, Hawley's reader 15 and computer 10 form an interrogator that accesses the unique identification code, manufacturer's URL, and drug identifier from each RFID tag's memory in order to retrieve information uniquely associated with container 20 (see Sections [0018] and [0033]).

Regarding claim 3, a material safety data sheet (MSDS) is a form containing data regarding the properties of a particular substance (as defined by Wikipedia). Consequently, the traditional paper "package insert" that is found with prescription drug containers is a material

safety data sheet (see Section [0018]). Per Hawley, each container 20 is associated with information that includes the MSDS for the drug (see Section [0018]).

Regarding claim 4, Hawley discloses that the MSDS is stored on the drug manufacturer's web site and is the most up-to-date (see Section [0018]); thus the MSDS is stored remotely from container 20 and must be updated.

Regarding claim 5, Hawley's interrogator is coupled to the updated MSDS information via network 25, which is an Internet connection (see Sections [0018] and [0026]).

Regarding claim 6, Hawley's interrogator is coupled by network 25 to a server (i.e., a data processor) that is hosting a drug manufacturer's web site, which includes the MSDS of its products (see Sections [0018], [0026], and [0027]).

Regarding claims 7 and 8, Hawley's interrogator has access to historical information, such as the manufacturer's identity, associated with container 20 as identified by the unique identification code and manufacturer's URL stored in the tag's memory (see Sections [0018], [0025], [0032], and [0033]).

Referring to claims 9 and 10, Hawley's method comprises: (a) placing an RFID tag on each product container 20, wherein each RFID tag has a unique identification code (see Sections [0011], [0018], and [0025]); (b) storing the drug manufacturer's URL code in each RFID tag's memory (see Sections [0018] and [0019]); (c) storing historical information, such as the drug identifier (i.e., product number, as called for in claim 10), in each RFID tag's memory (see Sections [0018] and [0019]); and (d) interrogating container 20's RFID tag and providing an Internet connection to obtain unique historical information, such as a drug's most up-to-date online "package insert" information (i.e., MSDS) and interaction information with other drugs, relating to a specific container 20 and its product contents (see Section [0018]). Hawley teaches

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that a tag for each prescription drug container specifies the URL of the manufacturer's home page (i.e., a first readable field), a data item identifying the particular drug (i.e., a second readable field), and information personalized to the individual purchaser (i.e., a third readable field) (see Section [0018]); thus Hawley's tag has at least two readable fields.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (571) 272-3062. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CY

3 February 2006


BRIAN ZIMMERMAN
PRIMARY EXAMINER